

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN C. GOODWIN III

Appeal No. 2003-0006
Application No. 09/099,546

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-15, which are all of the claims pending in the present application.

The claimed invention relates to a method and system for dispatching an individual carrying a pager in a transaction establishment in response to the receipt of a message indicative of a problem in the transaction establishment. The location of the problem is recorded and, utilizing the electronic price label

system of the transaction establishment, pagers associated with various individuals are located utilizing signal strength information determined from responses to query messages addressed to the pagers. An appropriate individual is chosen to respond to the problem and a message containing the location of the problem is sent to the pager carried by the chosen individual to alert the individual to respond to the problem.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of dispatching an individual in a transaction establishment comprising the steps of:

(a) receiving a message indicative of a problem in the transaction establishment;

(b) recording a location of the problem from the message;

(c) locating pagers carried by the individual and other individuals in the transaction establishment by an electronic price label system including the substeps of

(c-1) transmitting a query message addressed to the pagers;

(c-2) sending responses to the query message by the pagers;

(c-3) receiving the responses by a plurality of receivers; and

(c-4) determining locations of the pagers using signal strength information determined from the responses;

(d) choosing the individual to respond to the problem based upon the locations of the pagers; and

(e) sending a message containing the location of the problem to the pager carried by the individual to alert the individual to respond to the problem by the electronic price label system.

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The Examiner relies on the following prior art:

Ness	5,767,788	Jun. 16, 1998
Goodwin, III et al. (Goodwin)	5,818,346	Oct. 06, 1998
		(filed Feb. 16, 1996)

Claims 1-15 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Ness in view of Goodwin. Claims 1-15 stand further finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,818,346 (Goodwin) in view of Ness.¹

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (Paper No. 14) and Answer (Paper No. 17) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

¹As indicated at page 7 of the Answer, the Examiner has withdrawn the 35 U.S.C. § 112, second paragraph, rejection of claims 1-9 and 15.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims 1-15. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the 35 U.S.C. § 103(a) rejection of the appealed independent claims 1 and 7-10, Appellant's arguments in response (Brief, pages 20 and 21) assert a failure by the Examiner to set forth a prima facie case of obviousness since proper motivation for the proposed combination of Ness and Goodwin has not been established. After reviewing the applied Ness and Goodwin references in light of the arguments of record, we are in general agreement with Appellant's position as stated in the Brief.

In our view, the Examiner has combined the electronic price labeling features of Goodwin with the pager locating system of Ness in some vague manner without specifically describing how the teachings would be combined, nor how any such combination would satisfy the requirements of appealed independent claims 1 and 7-10. This does not persuade us that one of ordinary skill in the art having the references before her or him, and using her or his own knowledge of the art, would have been put in possession of the claimed subject matter. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the

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modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Further, our review of the Ness and Goodwin references reveals that they are directed to different problems with different solutions. In other words, while Ness discloses a system for locating and tracking emergency vehicles, there is no teaching or suggestion of using such a system in a transaction establishment, let alone one using an electronic price labeling system as claimed. Similarly, while Goodwin uses an electronic price labeling system to locate problem price labels, there is no indication of any suggestion to use the electronic price labeling in conjunction with a paging system to locate and dispatch workers to address the problem. Given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, it is our view that any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure and not from any teaching or suggestion in the references themselves.

In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C.

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§ 103(a) rejection of independent claims 1 and 7-10, as well as claims 2-6 and 11-15 dependent thereon, is not sustained.

We also do not sustain the Examiner's obviousness-type double patenting rejection of appealed claims 1-15 based on the combination of claims 1-20 of the Goodwin patent (U.S. Patent No. 5,818,346) and Ness. In making this rejection, the Examiner has looked to Ness to supply the worker dispatching and locating features missing from the electronic price labeling invention set forth in the claims of the Goodwin patent. For all of the reasons discussed supra, however, the Examiner has not established proper motivation for combining the dispatching and locating system of Ness with the teachings of an electronic price labeling system used in a transaction establishment. Further, even assuming, arguendo, that such a combination could be made, there is no indication that the resulting system would satisfy the specific combination set forth in the appealed claims.

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) and obviousness-type double patenting rejections of the

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claims on appeal. Accordingly, the decision of the Examiner
rejecting claims 1-15 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

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